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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,291	04/05/2001	Colin A. Waters	9385	5721
26884	7590	11/16/2005	EXAMINER	
PAUL W. MARTIN NCR CORPORATION, LAW DEPT. 1700 S. PATTERSON BLVD. DAYTON, OH 45479-0001			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/827,291	WATERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 August 2005.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,6-11 and 13-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,6-11 and 13-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

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#### **DETAILED ACTION**

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- No claims have been amended currently.
- Claims 5 and 12 were canceled.
- Claims 15-17 were added
- Claims 1-4, 6-11, and 13-17 are pending.

#### ***Response to Amendment***

2. Applicant's arguments with respect to claims 1, 6, 8, 13, and 15 and subsequent dependent claims, filed 25 August 2005, have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the filling date of the application being April 5, 2001 and the Pare '166 being June 11, 2001 and the Pare is not qualified as prior art is in err. Examiner would like to point out as applicant has admitted in page 3, section 2 and the footnote, Pare '166 is continuation of application no. 09/239,570 which is patent no. 6,269,348 that was filed on January 29, 1999 as admitted by the applicant. However, applicant is asserting that the content of the two applications are different therefore, the continuity is not valid. Examiner has reviewed both patents Pare '166 and Pare '348 extensively and concluded that they are identical in content and all the portions of the Pare '166 that the examiner has relied on rejecting the current claims in the application are present in the Pare '348. However, examiner would lie to invite the applicant to present the examiner with any specific column or line identification of the two mentioned prior art that might not be of exact content that the examiner has relied on in his rejection. Therefore, the examiner's rejection under U.S.C. § 103 is proper and establishes the merits of a *prima facie* case of obviousness under U.S.C. § 103 rejection. Hence, the rejections are maintained.

4. Additionally it should be noted as well that the rejection of the claims under 35 USC 103 is proper and applicant's arguments is not persuasive, since firstly, it is noted that although the examiner applied a

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103 rejection to claims 1-5, and 7, all the above said claims could have properly been rejected under 102 (e) using Pare '166 reference. However, since the claims were rejected under 103, that rejection is maintained (it is still proper because anticipation is the epitome of obviousness).

5. As for the argument the applicant has put forward in regards to the clarity of the rejection page 3 and 4, section 3, the applicant again is in err. What the applicant has argued regarding the rejection dated October 8, 2004, is the clarity of the rejection. However, examiner would like to point out that the rejection dated October 8, 2004 does not mention Pare '166 as a prior art and only Musgrave is used under U.S.C. § 102 rejection. Also, it should be mentioned that there has been a subsequent rejection dated May 24, 2005, that the examiner has addressed the arguments of the applicant regarding the October 8, 2005 arguments, which has incorporated by reference.

6. As for the arguments put forward by the applicant based on supposition that Pare '166 lacks "a database server operable to retrieve a financial account..." examiner would like to bring the attention of the applicant to figure 2B of the current application. The claims state clearly that a biometric data is captured and based on the biometric data a financial account is identified for transaction. One skilled in the art would know that any biometric information captured is translated into bits and bytes of information for further processing in a digital or an electronic system. The information captured is in 0 and 1 or binary numbers that in many ways can be utilized such as an indexing number (Indexing Key) in a data storage system for speedy lookup of data related to the indexing key such as personal identification, or financial account information. The captured biometric information is essentially used for authentication by way of matching of the stored information with that of provided information here the digitized fingerprint data as a binary number.. Also it should be noted that applicant in the specification of the current application in the summary section paragraph [0009] clearly states that "retrieving a data record corresponding to a consumer and retrieving a data record corresponding to the data storage key and the record contains customer financial account data". It clearly shows that the storage key (index key) is used to retrieve consumer data based on a step 144 in figure 2B that matches the biometric data captured with biometric data identified in the storage database, if there is a match proceeds to retrieve account data from record

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step 148. It should be noted that there is no indication of direct retrieval of the financial information from the biometric information or lack thereof any intermediary steps of authenticating the user before the financial account is identified. Therefore, there is an identification and authentication of the person providing the biometric information and then if there is no discrepancies and the biometric data match with stored biometric data in the database, then the identification of the financial account takes place, as it has been clearly disclosed by the Pare' 166 as it has been presented in the rejection below.

7. As for the database Pare '166 clearly discloses that a database is used as clearly has been stated in column 11, lines 46-57, as the data is stored in a database/server that is tasked with identification of a match of biometrics information.

8. In regards to arguments of no motivation to combine it is note worthy to point to the rulings below;

9. "Test is not what references expressly suggest but rather what the references taken collectively would have suggested to those skilled in the art. *In re Rosselet*, 146 USPQ 183 (1965) and *In re Keller*, 208 USPQ 871 (1981).

10. Further, "We have carefully weighted the appellant's comments, however, we note that it is not necessary that references actually suggest, expressly or in so many words, the changes or possible improvements the appellant has made." *In re Scheckler*, 58 CCPA 936, 438 F.2d 999, 168 USPQ 716 (1971). Also, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 57 CCPA 713, 416 F.2d 1385, 872 OG 1026, 163 USPQ 545 (1969).

11. Therefore the rejections of all the remaining claims 1-4, 6-11, and 13-17 in their current forms within the application under U.S.C. § 103 are maintained.

#### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-4, 6-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,662,166 to David Ferrin Pare, JR. et al. in view of U.S. Patent No. 6,202,151 to Clyde Musgrave.

14. As per claims 1, 3, 6, 8, 13, and 15, Pare clearly teaches a system and method for providing consumer access to a financial account to implement a transaction comprising:

a biometric data capture device for reading consumer biometric data (See pare figure 1 and 2 and associated text); and

a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, and column 9, lines 54-58)

a payment device for sending said compared biometric data to a merchant payment host as the identifier for the consumer's financial account data (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, column 9, lines 54-58, and column 15, lines 24-67).

an identity database comprised of data records stored with reference to a data storage key corresponding to biometric data contained within the data record so that the database server may retrieve records from the identity database using data storage keys generated from the received biometric data (See Pare figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 and lines 47-54, column 9, lines 54-58, column 11, line 46-column 12, line 23, and column 15, lines 24-67).

What is not clear and explicit from the teachings of Pare exactly how a digital signature (certificate) is generated from the biometric information (See Pare column 12, lines 5-23). How ever, Musgrave is specific and clear on application and use of specific biometric information and creating a

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hash value of the information and signing the biometric certificate and forwarding the data to the authenticating authority (See Musgrave column 5, line 15-column 6, line 24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to apply the Musgrave method and system within the method and system of Pare for the motivation of further enhancement of both security as well as accuracy as well as reduction of computational resources (See Musgrave column 3, lines 8-22)

15. As per claims 2, 4, 7, 9, 10, and 16, Pare clearly teaches all the limitations of claims 1, 3, 6, 8, and 9, further Pare teaches;

a payment device coupled to said biometric data capture device, said payment device generating a digital signature from said biometric data for a transaction message (See Pare column 9, lines 16-31, lines 49-52, and lines 59-64, and column 12, lines 5-23).

16. As per claims 11, 14, and 16, Pare clearly teaches all the limitations of claims 9, 13, and 15 further,

comparing the generated digital signature to a received digital signature to authorize generation of electronic funds in response to said generated digital signature corresponding to said received digital signature (See Pare column 12, lines 5-23).

17. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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**Conclusion**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure U.S. Patent to:

- U.S. Patent No. 5,870,723, To David F. Pare, Tokenless biometric transaction authorization method and system
- U.S. Patent No. 6,292,795, to Mathew Peters, Indexed file system and method and mechanism for accessing data records from such system.
- PCT Publication WO 96/08093, to George J. Tomko, Biometric controlled key generation

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

2. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

3. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

**(571) 273-8300** [Official communications; including After Final communications labeled "Box AF"]

**(571) 273-6702** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

**Knox Building, 50 Dulany St. Alexandria, VA.**

**Kambiz Abdi**  
Examiner

  
November 10, 2005